

### **REMARKS/ARGUMENTS**

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this Amendment, claims 43, 51, 61, 69, 71, and 75-77 have been amended solely for clarity, and claims 80-81 are added. Thus, claims 43-44, 47-54, 57-62, and 65-81 are pending for further examination.

#### **Objection to the Specification**

The specification remains objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. This objection is respectfully traversed for at least the following reasons.

Applicant continues to believe that the Office Action employs an overly formalistic, hyper-technical, and improperly rigid view of what is required by 37 C.F.R. § 1.75(d)(1) and MPEP 608.01(o). Contrary to the assertions in the Office Action, Applicant is not asking that any provisions of the C.F.R. or the MPEP be “waived.” Quite the contrary, Applicant is asking that the specification and claims be examined in accordance with the provisions therein. MPEP 608.01(o) states that “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import. . . .” Literal or “*in haec verba*” support is not required by either 37 C.F.R. § 1.75(d)(1) or MPEP 608.01(o). Rather, the sole requirement is that the meanings of claim terms be apparent from the specification and/or figures. Of course, most of the terms have meanings that already are apparent from the express language of the claims -- at least when such terms are read in context rather than being extracted therefrom.

In any event, the Office Action has not attempted to show how or why the meanings of listed claim terms are not apparent from the specification and/or figures. Nor has the Office

Action meaningfully acknowledged or responded to the fact that Applicant has pointed to specific exemplary portions of the specification and figures that add further context the meanings of the claim terms -- beyond their already-apparent meanings.

For the sake of brevity, Applicant incorporates herein the previous discussions of where and how the “meanings” of the claims terms are made yet more apparent in the specification and figures. The Examiner is kindly requested to respond to Applicant’s citations to the specifications and figures in detail. For example, Applicant wonders whether it really is the USPTO’s position that the meaning of the term “user interface” is not immediately apparent -- particularly in view of the exemplary screenshots shown in Figs. 3-6 and the corresponding discussions thereof. Furthermore, Because it is conceded that most of the allegedly objectionable terms have written description support, Applicant also wonders whether this objection could be overcome by simply amending the specification to insert such terms in exemplary locations. Of course, such a requirement would seem to elevate form over substance, effectively requiring action well beyond the strictures of 37 C.F.R. § 1.75(d)(1) and MPEP 608.01(o).

In view of the above, reconsideration and withdrawal of outstanding objections are respectfully requested.

**Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 43-44, 47-54, 57-62, and 65-79 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. It is believed that the explanations previously provided have already rendered moot each and every basis for this rejection, and the previous discussions are respectfully incorporated herein. Applicant certainly does not acquiesce to the propriety of any of these rejections.

First, with respect to the numerous rejections pertaining to the recitations of first and second storage locations, Applicant believes that the Office Action has cited to bits and pieces of the specification and figures and then confused their respective teachings. To resolve this confusion, the Examiner's attention is drawn to paragraph 31, which states in part:

“FIG. 6 shows another exemplary screen shot of a song selection screen 60 that is displayed when a user touches an album cover graphic from the screen 30 of FIG. 3. Thus, this screen shows an alternative (or typical) method of selecting a song, wherein the song is selected directly from the subset of songs that are directly available from the storage device of the jukebox itself (rather than the local server)” (emphasis added).

The underlined portion clearly establishes that the jukebox itself includes a first storage location from which songs are directly available. The underlined portion also clearly establishes that the local server includes a second storage location from which songs are directly available.

Although certain exemplary embodiments provide the local server separate from the jukebox devices, certain other exemplary embodiments include the local server as a part of a jukebox device. See, for example, paragraph 10. Thus, in those embodiments where a local server is built into a jukebox device, the jukebox device has its own first storage location and a second storage location provided by virtue of the local server incorporated therein. One skilled in the art would certainly recognize from at least these cited portions that the inventors were in possession of the invention at the time the application was filed.

With respect to the first and second encryption levels, Applicant has amended the specification as set forth above to provide literal support for the features called for in claims 51 and 69. See original claims 24-25 and MPEP 2163.06.

Applicant is at a loss as to how a central server that “includes” a repository of instances of media is not also a central server that is “operably connected to” a repository of instances of

media. In an effort to facilitate prosecution on the merits, however, Applicant has amended claim 53 so as to render moot the corresponding written description rejection thereof.

Applicant assumes that the rejection of claim 73 was intended to be made with respect to claim 71. Claim 73 does not call for all possible instances of media being stored on at least one storage location. Thus, to the extent that Office Action's reasoning is understood, the apparent premise on which the rejection is based plainly is incorrect.

In view of the above, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 50-52, 68-70, and 75-78 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. This rejection is once again respectfully traversed for at least the following reasons.

With respect to claims 50-51 and 68-69, Applicant respectfully points out that breadth is not to be confused with indefiniteness. See MPEP 2173.04, entitled "Breadth Is Not Indefiniteness." This rejection is facially improper for at least this reason. In any event, The scope of the subject matter embraced by claims 50-51 and 68-69 is clear. Applicant has not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims. One of ordinary skill in the art would plainly understand whether first and/or second levels of encryption are being used as evidenced by the references cited in the Office Action itself. There simply is no legitimate basis for rejecting these claims.

Applicant believes that claims 75-77 have been fundamentally misread such that it is not understood what these claims actually require. However, in an effort to facilitate prosecution on

the merits, Applicant has amended these claims so as to render moot the rejection. Of course, Applicant certainly does not acquiesce to the propriety of any of the § 112, second paragraph, rejections.

In view of the above, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejections under 35 U.S.C. § 103**

Claims 43-44, 47-49, 53-54, 57-62, and 65-67 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles (U.S. Patent No. 5,481,509) in view of Verduin (U.S. Patent No. 4,667,802). This rejection is respectfully traversed for at least the following reasons.

Claim 43 recites, *inter alia*, “a first storage location storing a first plurality of instances of media available for playback via the jukebox device for a first fee or number of credits; [and] a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits . . . wherein the first storage location is different from the second storage location, and wherein each said instance of media in the first and second storage locations is of a common type.” Claims 53 and 61 recite similar subject matter. These features are not present in Knowles or Verduin, alone or in combination. Thus, Knowles and Verduin, alone and in combination, do not render obvious these claims (or their dependents).

The Office Action concedes that Knowles does not teach or suggest “a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits . . . wherein the first storage location is different from the

second storage location” and cites to Verduin of make up for this admitted deficiency. Verduin relates to a video jukebox system. An object of Verduin’s invention “is to provide a video jukebox which provides for independent pricing of audio-video and strictly audio selections” (col. 1, lines 31-33). A further object Verduin’s invention is to “provide a video jukebox . . . which distinguishes between video and audio selections” (col. 1, lines 35-36). Verduin makes clear that its “video jukebox permits . . . the independent pricing of video and audio selections” (col. 6, lines 23-24). When Verduin is read as a whole, it becomes clear that there is absolutely nothing in Verduin that teaches or suggests the independent pricing of different subsets of video selections or different subsets of audio selections. As a result, Verduin does not teach or suggest the above-identified subject matter of claims 43, 53, and 61.

Even the alleged combination -- to the extent divined from the Office Action -- is deficient in this regard. Indeed, the Office Action does not appear to make any allegations regarding how one of ordinary skilled in the art at the time of the invention would have combined Knowles and Verduin. Applicant assumes that when the references are considered as a whole, the resulting combination would have been only a slightly more up-to-date version of Verduin in which a user is charged a first price for video selections and a second price for audio selections. But this combination is nothing like claims 43, 53, and 61 because it does not charge two different prices for a single type of instance of media based on the storage location storing that media.

Of course, the alleged motivation for combining Knowles and Verduin appears to be improper. The allegation that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks 52 for different priced media because then the computer could identify the hard disk and

charge accordingly instead of having to add metadata to the files or create a lookup table” is not supported by the references of record. For example, the words “metadata” and “lookup table” are not present in either of Knowles or Verduin. Of course, Applicant does not understand how Verduin’s price differentiation techniques for completely different media types and media sources could help “to designate each of the hard disks 52” of Knowles. The differences between a VCR and a record player in Verduin seem to be much greater than the differences between the different hard disks in Knowles -- especially since Knowles does not appear to specify what type of media goes on a particular hard drive. Simply stated, the Office Action lacks the necessary underlying facts to support the legal conclusion of obviousness. This is a further problem with the rejection of the above-identified claims (and their dependents).

Claims 50-51 and 68-69 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles and Verduin in view of Bowman-Amuah (U.S. Patent No. 6,289,382). Claims 52 and 70 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles and Bowman-Amuah, and further in view of Dunning (U.S. Patent No. 7,024,485). The further introduction of these additional references does not make up for the underlying fundamental deficiencies with respect to the alleged Knowles/Verduin combination. Thus, Applicant respectfully requests that all § 103 rejections be reversed as to claims 43, 53, and 61, and their respective dependents.

Claims 71-79 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles in view of Shneidlman (U.S. Publication No. 2006/0038794). This rejection is respectfully traversed for at least the following reasons.

Knowles simply does not teach price differentiation of any kind -- much less “a user interface provided to the jukebox device configured to receive input from a user corresponding to

a selection of an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device, the user interface comprising a first display screen configured to receive input from a user for the selection of the instance of media for playback from the first subset of media for a first fee or number of credits, and a second display screen configured to receive input from a user for the selection of the instance of media for playback from at least the second subset of media for a second fee or number of credits, the second fee or number of credits being greater than the first fee or number of credits,” as called for in claim 71.

The Office Action’s continued reliance on step 136 in Fig. 4A of Knowles is not understood. Knowles at col. 6, lines 50-52 merely states, “Once a genre has been selected, the program displays the titles available along with the price to play each title for the format and genre selected at a step 136.” But this single sentence says nothing of first and second display screens, much less of different prices being charged for whether a selection is made from the different screens. There is nothing in Knowles that teaches or suggests such a feature, and the introduction of Shneidman certainly does not make up for this fundamental deficiency of Knowles.

Thus, reconsideration and withdrawal of this § 103 rejection are respectfully requested.

#### **New Claims**

New claims 80-81 have been added to encompass further originally described subject matter. These new claims should be allowable at least by virtue of their dependence from allowable claim 71, as well as the additional features recited therein.



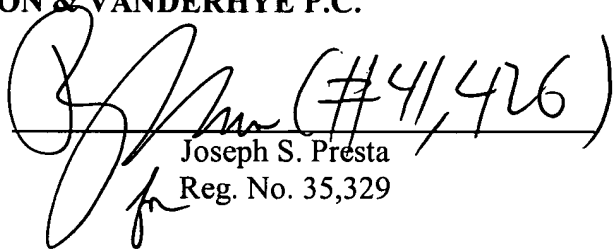
**Conclusion**

Applicant believes that all of the pending claims clearly and patentably distinguish the prior art of record and are in condition for allowance. Thus, passage of this case to issuance at an early date is earnestly solicited. Should the Examiner have any questions, or deem that any further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

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